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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/834,651      | 04/16/2001  | Takeshi Fukuda       | 05453.0037          | 3687             |

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[REDACTED] EXAMINER

[REDACTED] WELLS, LAUREN Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1617     | [REDACTED] 5 |

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                      |                     |  |
|------------------------------|----------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Applicant No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/834,651           | FUKUDA ET AL.       |  |
|                              | <b>Examiner</b>      | <b>Art Unit</b>     |  |
|                              | Lauren Q Wells       | 1617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 May 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 6-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

Claims 1-10 are pending. Claims 4-5 are withdrawn from consideration, as they are directed to non-elected subject matter.

### ***Election/Restrictions***

Applicant's election without traverse of Group I in Paper No. 4 is acknowledged. This Restriction Requirement is hereby made final.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 1-3, 6-10 are rejected because the compound in these claims is not defined with any chemical or physical characteristic, but only by functional properties. A claim to a material defined solely in terms of what it can do, or a property thereof, does not particularly point out the claimed invention. Thus, the scope is indefinite. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169.

(ii) The term "flake-like-alpha-alumina particle" in claims 1-3 and 6-10 is vague and indefinite, as the metes and bounds of these claims are unascertainable. It is not clear what exactly is being claimed. Is a flaky alumina particle being claimed, or is something similar to a flaky alumina particle being claimed? Deleting the term "like" and replacing "flake" with "flaky" will overcome this rejection.

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(iii) The term "thin flat form" in claim 1 (line 4) is a relative term which renders the claim indefinite. The term "thin flat form" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Quantitatively, what defines thin, such that it is flat?

(iv) Claim 2 is vague and indefinite, as it is confusing. First, what is oxide P<sub>2</sub>O<sub>5</sub>? Is P<sub>2</sub>O<sub>5</sub> the oxide? Second, does the phrase "in terms of" mean that P<sub>2</sub>O<sub>5</sub> is the phosphoric compound recited in line 2 of the claim?

(v) The phrase "wherein the flake-like-alpha-alumina particles are compounded in an amount of 1 to 90% by weight based on the weight of the cosmetic" in claims 8 and 10 is vague and indefinite, as it is confusing. What does it mean that the particles are compounded?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibasaki et al. (5,587,010).

Shibasaki et al. teach a process for producing fine flaky alumina particles and alumina-based plastic material. It is disclosed that the particles can be combined with an organic water holding material and water. The particles are disclosed as having a size of 1um or less, a thickness of 0.1um or less, and a diameter ranging from 0.5-3.5um. The alumina particles are

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disclosed as comprising 63-67% of a composition comprising water and polyethylene glycol.

The reference lacks an exemplification of major diameter, thin flat form. See Col. 2, line 52-Col. 4, line 20; Col. 5, lines 9-11; Col. 6, lines 1-38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the flaky alumina particle of Shibasaki et al. as a) having a major diameter of 0.5-3.5um, because Shibasaki et al. teach that depending on the hydrothermal synthesis process, the size of the particles can range from 0.5-3.5um; and as b) having a thin and flat form, because Shibasaki et al. teach the particles as having a thickness of 0.1um, which is thin, and as having a hexagonal form, which is flat.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibasaki et al. in view of Fukuda et al. (6,197,277).

Shibasaki et al. is applied as discussed above. The reference lacks P2O5 and zeta-potential.

Fukuda et al. teach alumina particles having high dispersibility and plasticity. The particles are disclosed as comprising 0.1-3% P2O5. It is disclosed that the isoelectric point at which the zeta-potential is 0 is of pH 4 to 8. See abstract; Col. 3, line 8-27; Col. 4, line 65-Col. 5, line 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the P2O5 of Fukuda et al. into the alumina particles of Shibasaki et al. because a) Fukuda et al. and Shibasaki et al. are both directed to flaky alumina particles for use in paints and ceramic molding, and; b) Fukuda et al. teach the addition of P2O5 to alumina particles as producing paints or ceramics with high dispersibility and plasticity.

***Notes***

The Examiner respectfully points out the definition of a cosmetic, "something superficial that is used to cover a deficit or defect".<sup>1</sup> The Examiner respectfully points out that a paint falls within this definition.

***Unexpected Results***

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the data on pages 15-25 of the specification have been considered but not found persuasive because the data merely demonstrate the effectiveness of adding P2O5 to alumina particles. This is seen to be an expected result based on the cited prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
July 3, 2002

  
RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200